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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,261	11/10/2000	John DeMayo	2580-019	6688
22852	7590	08/02/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/711,261

Applicant(s)

DEMAYO ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5-25-04.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed with an amendment on 22 April 2004 have been fully considered but they are not persuasive. Para. 5-7 below have been rewritten to address some of the arguments. The arguments are discussed at para. 7, 10-11 and 15 below.

### *Claim Rejections - 35 USC § 102 and 35 USC § 103*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 4-6, 9-10, 12-13, 21 and 24 are rejected under 35 U.S.C. 102(e) as being as anticipated by Bull et al.
5. Bull et al. teaches (independent claims 1, 9, 21 and 24) an apparatus and method for hyperlinking specific words in content or in text-containing files, or displayed in an application, to turn the words into advertisements, the method comprising: connecting a content provider server to the Internet, said content provider having content files to be displayed (col. 3 lines 31-34 and 66-67); providing an advertiser web page so as to be accessible over the Internet (col. 5 lines 11-12); and connecting an ad server (*advertiser's computer system 400*, col. 8 line 10 and Fig. 1) to the Internet, wherein the ad server

provides a *hot link* (col. 8 line 20), which reads on a hypertext link or hyperlink (Microsoft Press Computer Dictionary), to a word or phrase (e.g., *Inns on the West Coast*, col. 15 lines 39-42) in a content file to link an Internet-enabled web browsing device connected to the Internet to said advertiser web page (col. 15 lines 24-25).

6. Bull et al. also teaches that said word or phrase is advertiser-chosen. The reference teaches that the advertiser chooses the criteria by which the ads are placed (col. 8 lines 3-5 and 19-22), said advertiser-chosen criteria being used to choose said word or phrase (col. 5 lines 14-25).
7. Bull et al. does not explicitly teach a hypertext anchor to said advertiser-chosen word or phrase. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, the reference teaches ads hyperlinked (col. 4 lines 29-30 and col. 8 lines 19-21) to pages based on keywords in the content of that page (col. 5 lines 11-12 and 19-20). If a hyperlink is executed from text, there must be a hyperlink anchor at said text (Microsoft Press Computer Dictionary definition 2 of "anchor"). Since the hyperlink is executed by the appearance of the keyword(s) or advertiser-chosen word or phrase, the anchor is, by definition, at said advertiser-chosen word or phrase.
8. Applicant argues (pp. 11-13) that "... inserting an ad into an existing web page, as taught by the reference, is not the same as linking a word or phrase to an advertiser's web page, as recited at claim 1. Indeed the Background section of the present application discloses many drawbacks of conventional systems that display advertising alongside content". First, a hyperlink must have two ends, one of which is necessarily connected to the ad. It is the ad end of the hyperlink which is provided by advertisers. Secondly, there is no claim limitation as to the size and placement of the ads in the display. Hence it is immaterial whether the reference teaches that ads are displayed alongside content.
9. Bull et al. also teaches at the citations given above claims 2, 4-6, 10, 12 and 13.
10. Claims 3, 7, 11, 14-15, 22 and 25 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. Bull et al. does not teach (claims 3, 11, 22 and 25) using a script to provide a hypertext anchor and (claims 7 and 14-15) using frames to display the content provider URL in a browser window. Official notice is taken (MPEP § 2144.03) that it was common, at the

time of the instant invention, to use script to provide a hypertext anchor and display the URL of content in a browser window using frames. Because it is efficient to use common and well known practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Bull et al. the use of script to provide a hypertext anchor and the use of frames to display the content provider URL in a browser window.

11. Traverse of the taking of Official Notice - On p. 13, applicant has traversed the examiner's taking of official notice (in para. 9 above). However, applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). In particular, applicant has not provided evidence to traverse the examiner's assertion that it was common, at the time of the instant invention, to use script to provide a hypertext anchor. Applicant has argued that it was not common to use script to overwrite the existing HTML of a content file. But that is inherent whenever adding an anchor to an existing content file. Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained.
12. Claims 8, 16, 23 and 26 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Portuesi. Bull et al. does not teach using a tracking URL to link to said advertiser web page. Portuesi teaches using a tracking URL to link to a web page (col. 4 lines 47-65). Because Portuesi teaches that this enables linking to a time-based medium (col. 2 lines 22-24), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Portuesi to the teachings of Bull et al. Applicant argues (p. 16 middle) that there is no justification for adding Portuesi to the teachings of Bull et al. But applicant does not address the justification given in this paragraph after "Because".
13. Claims 17-19 and 27-29 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Murray.
14. Bull et al. does not teach (independent claims 17 and 27) the advertiser compensating at least one of a content provider and an entity that selects said hypertext anchor. Murray teaches the advertiser compensating at least one of a content provider and an entity that selects said hypertext anchor (col. 8 lines 19-20). Because it facilitates the acceptance of

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advertising (col. 2 lines 22-24), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Murray to the teachings of Bull et al.

15. Applicant argues (p. 17) that the examiner has not addressed every limitation of independent claims 17 and 27. Claims 17 and 27 contain many of the elements of independent claims 1, 9, 21 and 24, which are addressed at para. 5-8 above.
16. Murray also teaches claims 18 and 28 at the citation given above.
17. Neither of the references teach the compensation schemes of claims 19 and 29. Official notice is taken (MPEP § 2144.03) that several of the compensation schemes were common at the time of the instant invention. Because it is efficient to use common and well-known practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add these compensation schemes to the teachings of Bull et al. and Murray.
18. Claims 20 and 30 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Murray and further in view of Portuesi. Neither Bull et al. nor Murray teaches using a tracking URL to link to said advertiser web page. Portuesi teaches using a tracking URL to link to a web page (col. 4 lines 47-65). Because Portuesi teaches that this enables linking to a time-based medium (col. 2 lines 22-24), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Portuesi to the teachings of Bull et al. and Murray.

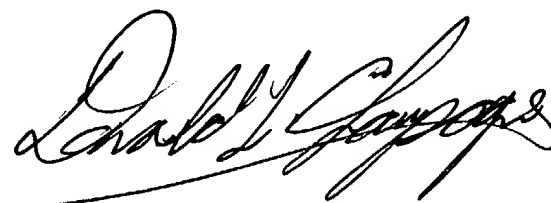
### ***Conclusion***

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
22. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
23. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
24. Applicant may have after final arguments considered and amendments entered by filing an RCE.
25. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

27 July 2004



Donald L. Champagne  
Primary Examiner  
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